

REMARKS

The specification has been amended to update the domestic priority information. The drawings have been amended to correct a typographical error in Figure 10.

Claims 21 and 25-27 have been amended and new claims 31-35 have been added. Specifically, claim 21 has been amended to recite “mounting the stud in a fistula formed in a part of the wearer’s mouth” as supported on page 2, lines 3-10; page 4, lines 15-22; page 6, lines 6-10; and page 9, lines 3-10, of the specification as originally filed.

Claims 25-27 have been amended to delete the phrase “the substance includes,” which has no limiting effect on the scope of these claims. Rather, the present amendment actually broadens the scope of these claims.

New independent claim 31 recites a “method for dispensing a substance into a mouth, wherein the substance is a medication” as supported by original claims 1, 26, 27, and as supported in the originally filed specification on page 6, lines 10-13.

New claims 32 and 33 each depend on claim 31, and recite that the fistula is formed “in the wearer’s tongue” and “in the wearer’s lip” as supported on page 2, lines 3-7, and on page 9, lines 3-10, of the specification as originally filed.

New claims 34 and 35 each depend on claim 21, and recite that the fistula is formed “in the wearer’s tongue” and “in the wearer’s lip” as supported on page 2, lines 3-7, and on page 9, lines 3-10, of the specification as originally filed.

The present amendment adds no new matter to the instant application.

The Invention

The present invention pertains broadly to a method for dispensing a substance into a mouth, such as could be used to dispense a breath freshener, a flavoring agent, a medication, or a combination of these substances. In one embodiment of the present invention, a method of dispensing a substance

into a mouth, wherein the substance is selected from the group consisting of a breath freshener and a flavoring agent, is provided comprising the steps recited in claim 21. In another embodiment of the present invention, a method of dispensing a substance into a mouth, wherein the substance is a medication, is provided comprising the steps recited in claim 31.

Various other embodiment, in accordance with the present invention, are recited in the dependent claims. All of the embodiments, in accordance with the present invention, provide the advantage of using a “mouth and tongue stud” to dispense a substance into a wearer’s mouth.

The Rejection

Claims 21, 22, 28 and 29 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Katz (U.S. Patent 6,326,022). Claims 23-27 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Katz (U.S. Patent 6,326,022).

Applicant respectfully traverses the rejection and requests reconsideration of the application for the following reasons.

Applicant’s Arguments

In view of the present amendment, it is clear that claim 21 is directed to a “method for dispensing a substance into a mouth, wherein the substance is selected from the group consisting of a breath freshener and a flavoring agent” and claim 31 is directed to a “method for dispensing a substance into a mouth, wherein the substance is a medication.” Claims 25-27 are proper dependent claims, pertaining to a medication mixed with the substance (i.e., the breath freshener and/or flavoring agent). As described on page 2, lines 16-18, and on page 3, lines 7-9, of the specification as originally filed, any combination of breath freshener and/or flavoring agent substances may be combined with a medication. Therefore, the objection to claims 25-27 should be withdrawn.

Prior Art Rejection

Anticipation under 35 U.S.C. § 102 requires showing the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). In the present case, the Section 102 rejection is untenable and must be withdrawn because the reference fails to teach each and every element of the claimed invention, arranged as in the claims.

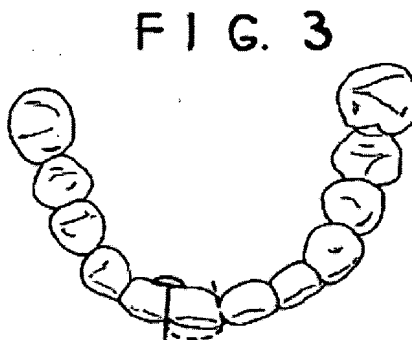
The Katz Patent

U.S. Patent 6,326,022 B1 to Katz (hereafter, the Katz Patent) teaches “slow-release disposable elastomeric buccal devices” as shown in Figures 1A, 1B, 1C, 3, 4, 5, 6, 7, 8, 9, 10, 12, 13, 14, 15, 19 and 20. As is clear from the Katz Patent, the device it discloses is constructed to be “held in a fixed position between two teeth in an unobtrusive manner” (col. 1, lines 23-26). It is a device that is “gripped and held between two teeth” due to the tendency of the stretched elastomer to return to its original thickness” (col. 3, lines 6-8). In fact, the “device can be inserted between any two teeth with the usual small gap between teeth” (col. 7, lines 43-47). Nowhere does the Katz Patent teach, or even suggest, that the device disclosed therein is suitable for use anywhere else but between two teeth.

In a word, the Katz Patent fails to teach, or even suggest, a “mouth and tongue stud” in accordance with the present invention. The Federal Circuit has ruled that the United States Patent and Trademark Office (USPTO) must give a fair reading to what a reference teaches as a whole. In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). In the present case, the Katz Patent plainly teaches a device constructed so as to be insertable between two teeth. On the other hand, a “mouth and tongue stud,” in accordance with the present invention, is a device that is inserted in a fistulous tract in the mouth or tongue of the wearer (See page 2, lines 3-7, and page 4, lines 20-22, of the specification as originally filed). In fact, the device taught by Katz is preferably constructed so as not to extend into the mouth and cause annoyance to the tongue (col. 7, lines 22-26). For all of these

reasons, the Katz Patent does not reasonably teach, or even suggest, a “mouth and tongue stud.” Therefore, the Katz Patent cannot teach, or even suggest, the step of “providing a mouth and tongue stud...” as recited in independent claims 21 and 31.

However, this is not the only deficiency of the teachings of the Katz Patent. The Katz Patent plainly and clearly teaches that the device is inserted between any two teeth (col. 1, lines 23-25, and col. 7, lines 43-55). The device taught by Katz does not extend into the mouth to annoy the tongue and it does not extend against the inside of the lip (col. 7, lines 49-55). In other words, not only is the device taught by the Katz Patent not a “mouth and tongue stud” as evident from Figure 3 of Katz (reproduced below), but when in use the Katz device is not to contact the tongue or the lip (col. 7, lines 22-26 and lines 49-55).



Plainly, the Katz Patent does not teach, or even suggest, “mounting the stud in a fistula formed in a part of a wearer’s mouth” as recited in independent claims 21 and 31. A “fistula” is an abnormal passage from one epithelialized surface to another epithelialized surface (See Stedman’s medical dictionary (1995) at 657). A gap between two teeth is not a “fistula.”

Conclusion

The rejection of claims 21, 22, 28 and 29 under 35 U.S.C. § 102(b), and of claims 23-27 and 30 under 35 U.S.C. § 103(a), over the Katz Patent is untenable and must be withdrawn because the Katz patent does not teach, or even suggest, (i) “providing a mouth and tongue stud” and (ii) “mounting the stud in a fistula formed in a part of a wearer’s mouth” as recited in independent claims 21 and 31.

For all of the above reasons, claims 21-35 are in condition for allowance and a prompt notice of allowance is earnestly solicited.

Questions are welcomed by the below-signed applicant.

Respectfully submitted,

GRIFFIN & SZIPL, PC

A handwritten signature in black ink, appearing to read "W. Scott Ashton", written over a horizontal line.

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IN THE DRAWINGS:

The attached sheet of drawings includes changes to Figure 10. This sheet, which includes Figures 9 and 10, replaces the original sheet including Figures 9 and 10. Figure 10 has been amended to replace character reference "10" with character reference --800--.

The present amendment adds no new matter to the drawings.

Attachment: Replacement Sheet
Annotated Sheet Showing Changes

